

REMARKS

Claims 1, 9-21, 24-32, and 34-39 stand rejected. The examiner has indicated that the restriction of claims 2-8, 22, 23, 33 and 40-86 has been made final.

Restriction Requirement

In response to the Office Action mailed on March 17, 2004, applicants acknowledge, with traverse, the Examiner's position regarding the finality of the Restriction Requirement dated November 24, 1993. Applicants respectfully request that the claims which were withdrawn from consideration by the Examiner be held in abeyance pending a determination as to whether claim 1 (which the Examiner has indicated is generic to Groups B1, B2 and B3, see Nov. 20, 2003 restriction requirement at page 3) is ultimately found to be allowable. In addition, Applicants maintain that the restriction of Group B2 from Group B1 is improper because claim 40 could be re-written as dependent on claim 15 by adding the limitations of claims 16 and 17 to claim 15, and continue to traverse the restriction requirement.

The Applicants respectfully assert that the reasoning in the March 17, 2004 office action at page 2 is incorrect, and respectfully request reconsideration and withdrawal of the restriction requirement:

- (a) subspecies B2 does not have a "separate utility such as patterning a substrate," because the coverage of claim 1 includes patterning a substrate. In fact, claims 16 and 17, which are ultimately dependent on claim 1, and which have already been examined, include limitations directed to substrate patterning; and
- (b) the assertion that the limitation of "depositing a thin metal film over a substrate" is present in subspecies B1 but not subspecies B2 is also incorrect. Claim 40 of subspecies B2 includes the limitations:

depositing an organic layer over a substrate;
depositing a thin metal film over the organic layer;

As a result, the thin metal film is deposited over the substrate, albeit with an organic layer in between. The point that the thin metal film of claim 1 need not be deposited directly on the substrate is made explicit in claim 13

(dependent on claim 1), which requires the deposition of an organic layer between the substrate and the thin metal film. See also specification at para. 49.

The applicants incorporate by reference the specific details of the traversal of the restriction requirement made on December 23, 2003.

Moreover, the assertion that the “a serious burden would be placed on the examiner” is also incorrect. Claim 40 (subspecies B2) as originally filed was *identical in scope* to claim 17 (subspecies B1), *which has already been examined*. The limitations in claims dependent on claim 40 are also similar to limitations that have already been examined.

Amendment to Abstract

Correction of the abstract was required, to limit the abstract to 50-150 words. The abstract has been amended, and now contains about 125 words.

Claim Rejections - 35 USC 103

Claims 1, 9-21, 24-32 and 34-39 stand rejected as obvious over Kim (US 6,294,398) in view of Whitesides (US 5,900,160).

The Applicants respectfully assert that Kim ‘398 is not prior art for purposes of the 103 rejection. The ‘398 patent was first published on September 25, 2001, which is after the June 6, 2001 filing date of the present application, so the ‘398 patent is not prior art under 35 USC 102 (a) or (b).

Regarding 102(e), the Applicants make the following statement (on a separate page per MPEP 706.02(l)(3):

Statement Regarding Ownership

Application 09/833,695 and Patent 6,294,398 were, at the time the invention of Application 09/833,695 was made, owned by the Trustees of the University of Princeton.

The Applicants respectfully assert that the statement on the preceding page, alone, is sufficient evidence to disqualify the '398 patent from being used in a rejection under 35 USC 102(e) / 103(a) against the claims of Application 09/833,695. See MPEP 706.02(l)(3).

The sections of 35 USC 102 other than (a), (b) and (e) do not appear to be applicable.

All pending rejections of the claims are under 35 USC 103 and based on combinations that include the '398 patent. Because the '398 patent is not available as prior art for this purpose, the Applicants respectfully request that the examiner reconsider and withdraw the rejection.

Comment re: Finality of Rejection

Regarding the finality of any second office action that may issue in this case, the Applicants respectfully direct the examiner's attention to MPEP 706.07(a). Once Kim '398 is disqualified as a reference, any new ground of rejection will not be necessitated by Applicants' amendment of the claims -- because none of the claims were amended. Making such an office action final is therefore improper. The impropriety of a final rejection after a reference is disqualified by a statement of common ownership is specifically and expressly addressed in MPEP 706.07(a).

Summary of Interview

Pursuant to MPEP 713.04, and labeled according to the letters therein, the Applicants summarize the June 18, 2004 interview:

- (A) no exhibit was shown
- (B) claims 1 and 40 were discussed
- (C) references US 5,900,160 and US 6,294,398 were discussed.
- (D) Although Applicants do not believe that it would change the scope of claim 40 at all due to limitations in the body of the claim referring to a substrate, Applicants suggested amending the preamble of claim 40 to remove the reference to "substrate," making claim 40 verbatim identical to claim 17 rewritten in independent format, in order to overcome the restriction requirement. The Applicants and the Examiner were unable to reach agreement regarding the restriction requirement.
- (E) Applicants argued that removing metal with a stamp and depositing metal from a stamp are different. Applicants further argued that depositing something other than metal with a stamp, such as the self-assembling monolayer of Whitesides, does not


apply to depositing metal, because the properties of metal and a self assembled monolayer are materially different.

- (F) No comment
- (G) Agreement was not reached
- (H) There was no e-mail communication between Applicants and the PTO.

CONCLUSION

Withdrawal of all pending objections and rejections, and allowance of the above-reference application, is respectfully requested. The Commissioner is authorized to charge any fees relevant to this filing to Kenyon & Kenyon Deposit Account 11-0600. The Examiner is invited to contact John McGroarty at (202) 220-4227 to discuss any matter concerning this application.

Respectfully submitted,


John McGroarty
Registration No. 41,186

DATE: June 28, 2004

KENYON & KENYON
1500 K Street, N.W., Suite 700
Washington, D.C. 20005-1257
(202) 220-4200 (Tel)
(202) 220-4201 (Fax)

DC01 477822 v 1